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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,429	12/27/2001	Aiko Okajima	016907-1353	1561
7590 03/03/2006				
FOLEY AND LARDNER 3000 K Street NW Washington, DC 20007			EXAMINER PARK, CHAN S	
			ART UNIT 2622	PAPER NUMBER

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/026,429	Applicant(s) OKAJIMA, AIKO	
	Examiner CHAN S. PARK	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 April 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

DOUGLAS Q. TRAN
PRIMARY EXAMINER

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 1/18/06, and has been entered and made of record. Currently, **claims 1-15** are pending.

Response to Arguments

2. Applicant's arguments with respect to **claims 1-15** have been considered but are moot in view of the new ground(s) of rejection.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the determining step, during a printing job receiving process in the receiving section must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

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consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 6 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite "*a determining section which determines, during a printing job receiving process in the receiving section...*" (claim 1 as an example). However, referring to figs. 3 & 5 and page 8, lines 5-8 of the original Specification, the determination is done *after* the printing job is completely received. That is, step 3 (the determination step) is processed only after step 2 (receiving step). Further, the Specification states "the control section 2 determines whether the received printing job includes special printing" (step 3) (lines 7-8). Again,

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this statement bolsters the examiner's point that the determining step is not processed during the receiving process. Therefore, the examiner believes that the determining step occurs *after, not during*, the printing job receiving process according to the Specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear as to whether the extracted printing job ever gets printed. In other words, what happens to the *extracted* printing job that does not include the special printing?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6-8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chori et al. Japanese Patent Publication No. 2000-159391 (hereinafter Chori) in view of Ban U.S. Patent No. 6,332,170.

6. With respect to claim 1, Chori discloses a printer comprising:

a receiving section which receives printing jobs (paragraph 37);

a storage section which stores the received printing jobs (paragraph 21);

a printing section which executes the printing jobs extracted from the storage section (paragraph 38);

a determining section which determines, after a printing job receiving process in the receiving section, whether a page index of each page or a job index of the printing job (the print command including the feed stage information and the image size) which has been received includes information on special printing (paragraphs 40-42);

a display section which displays the printing jobs that are determined as including information on the special printing in the page index or the job index by the determination section (paragraph 43);

an input section which accepts a printing job selected by a user from the displayed printing jobs (paragraphs 43 & 44); and

a control section which extracts from the storage section the printing job selected by the user, and causes the printing section to execute the selected printing job (paragraphs 43 & 44).

Chori, however, does not disclose the printer having the display section which displays a *list* of the printing jobs and the input section which accepts the printing job selected by a user from the *displayed list*.

Ban, the same field of endeavor of the special printing art, discloses a printer (network printer in fig. 1) comprising:

- a receiving section (NIC 16 in fig. 2) which receives printing jobs;
- a storage section which stores the received printing jobs (col. 3, lines 39-40);
- a printing section which executes the printing jobs extracted from the storage section (fig. 4);
- a determining section which determines whether the printing jobs received by the receiving section include special printing (fig. 4 & col. 2, lines 26-27);
- a display section which displays a list of the printing jobs that are determined as including the special printing by the determining section (fig. 4 & col. 2, lines 26-27);
- an input section which accepts a printing job selected by a user from the displayed list (fig. 4); and
- a control section which extracts from the storage section the printing job selected by the user, and causes the printing section to execute it (col. 4, lines 19-38).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the printing job list display function of Ban into the printer of Chori.

The suggestion/motivation for doing so would have been to provide the user with the list of the special printing jobs in the printer for the selection.

Therefore, it would have been obvious to combine Chori with Ban to obtain the invention as specified in claim 1.

7. With respect to claim 2, Chori discloses the printer, wherein the control section extracts a printing job that does not include the special printing from the storage section (paragraph 39) and causes the printing section to execute the selected printing job (paragraphs 43 & 44).

8. With respect to claim 3, Chori discloses the printer, wherein the special printing is printing on a special paper sheet other than a normal paper sheet (paragraphs 40 & 41).

9. With respect to claim 14, the combination of Chori and Ban discloses the printer according to claim 1, wherein the control section prevents the printing section from printing any of the received printing jobs that include information on the special printing that are stored in the storage section (paragraphs 43 & 44 of Chori), until the input section receives a selection made by the user for printing one or more of the received printing jobs that include information on the special printing (fig. 4 of Ban).

10. With respect to claim 6, Chori discloses a print system comprising:

at least one terminal which receives data input for printing and sends a printing job for executing the printing based on the input data; and

a printer which is networked to the terminal and executes the printing job sent from the terminal to print data (fig. 5).

With respect to rest of the claim, arguments analogous to those presented for claim 1, are applicable.

11. With respect to claim 7, arguments analogous to those presented for claim 2, are applicable.

12. With respect to claim 8, arguments analogous to those presented for claim 3, are applicable.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Chori and Ban as applied to claim 3 above, and further in view of Eisenberg et al. U.S. Patent No. 6,452,694 (hereinafter Eisenberg).

13. With respect to claim 4, the combination discloses the printer according to claim 3 but it does not disclose expressly that the special printing is printing on a special paper sheet is a tab paper sheet.

Eisenberg, the same field of endeavor of the special paper printer, discloses a printer for performing a special printing on a special paper sheet, wherein the special paper sheet is a tab paper (Abstract).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the tab paper printing system of Eisenberg into the printer of Ban.

The suggestion/motivation for doing so would have been to correctly print text and/or graphic objects in the tab area of the tab sheet.

Therefore, it would have been obvious to combine the three references to obtain the invention as specified in claim 4.

14. With respect to claim 9, arguments analogous to those presented for claim 4, are applicable.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Chori and Ban as applied to claim 3 above, and further in view of Osari et al. U.S. Patent No. 6,169,863 (hereinafter Osari).

15. With respect to claim 5, the combination discloses the printer according to claim 3, further comprising:

a paper feed section which feeds a special paper sheet to the printing section (col. 3, line 31); and

a sensor which senses absence of a special paper sheet in the paper feed section (col. 3, lines 32-34),

wherein when a printing job including the special printing is selected by the user through the input section (col. 4, lines 6-38).

Ban, however, does not disclose expressly that the control section causes the display section to display absence of the special paper sheet, on condition that the sensor senses absence of the special paper sheet in the paper feed section.

Osari, the same field of endeavor of the manual feed-in printing system, discloses

a paper feed section which feeds a special paper sheet to the printing section (fig. 7A); and

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a sensor which senses absence of a special paper sheet in the paper feed section (col. 8, lines 1-12),

a control section causes the display section to display absence of the special paper sheet, on condition that the sensor senses absence of the special paper sheet in the paper feed section (col. 8, lines 10-12).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the display of 'no sheet on the manual feed tray' into the printer of Ban.

The suggestion/motivation for doing so would have been to inform the user that there is no sheet present in the feed tray.

Therefore, it would have been obvious to combine the three references to obtain the invention as specified in claim 5.

16. With respect to claim 10, arguments analogous to those presented for claim 5, are applicable.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Chori and Ban as applied to claim 1 above, and further in view of Matsuura et al. U.S. Patent No. 6,930,796 (hereinafter Matsuura).

17. With respect to claim 15, the combination of Chori and Ban discloses the printer according to claim 14, but it does not explicitly disclose that the one or more of the

received printing jobs that include information on the special printing also include information on normal printing of at least one or more sheets of paper.

Matsuura, the same field of endeavor of the special printing art, discloses the printer wherein the printer receives one or more of printing jobs that information on the special printing also include information on normal printing of at least one or more sheets of paper (fig. 4).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the function of receiving a special printing job which also includes information on normal printing of at least one or more sheets of paper into the printer of Chori.

The suggestion/motivation for doing so would have been to process each page of a particular printing job based on the unique characteristics/information of the each page.

Therefore, it would have been obvious to combine the three references to obtain the invention as specified in claim 15.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **CHAN S. PARK** whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

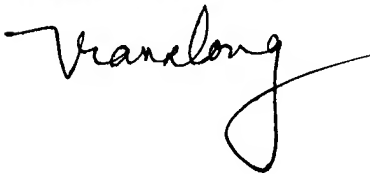
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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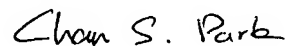
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csp
February 28, 2006

DOUGLAS Q. TRAN
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Tranlong', written over the printed name of Douglas Q. Tran.

Chan S. Park
Examiner
Art Unit 2625

A handwritten signature in black ink, appearing to read 'Chan S. Park', written over the printed name of Chan S. Park.